

**REMARKS / ARGUMENTS**

Claims 16-53 are pending in the instant application. Claims 16 and 32 are independent. Claims 17-31, 48, 50-51 and 33-46, 49, 52-53 depend from independent claims 16 and 32, respectively. New claims 50-53 have been added. Support for the new claims may be found in, for example, Fig. 2C and paragraph 62 of the specification.

By this Amendment, claims 1-47 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 16, 19-23, 25, 27, 29-32, 36-39, 41, 43 and 45-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 7,237,029 ("Hino"), in view of USP 6,446,192 ("Narasimhan"). Claims 17-18, 26, 28, 33-34, 42 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 7,237,029 ("Hino"), in view of USP 6,446,192 ("Narasimhan"), and in further view of USPP 2004/0003051 ("Krzyszowski"). Claims 24 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 7,237,029 ("Hino"), in view of USP 6,446,192 ("Narasimhan"), and in further view of USP 6,363,434 ("Eytchison").

Though the Applicant generally disagrees with such rejections, to expedite allowance of various pending claims, the following discussion will focus in part on particular independent and dependent claims and/or portions thereof. Note that such

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focus is in no way to be construed as the Applicant agreeing with any rejections not specifically discussed below. The Applicant respectfully traverses the above rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

### REJECTION UNDER 35 U.S.C. § 103

The determination of obviousness is a legal conclusion based on underlying findings of fact.<sup>1</sup> The factual inquiries, set forth in *Graham v. John Deere Co.*<sup>2</sup>, include: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims, (3) the level of ordinary skill in the relevant art, and (4) any objective indicia of non-obviousness. Initially, the burden is on the Examiner to establish a *prima facie* case of obviousness<sup>3</sup>. “If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”<sup>4</sup> More specifically, MPEP at § 2142 states:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

“The determination of obviousness is made with respect to the subject matter as a whole, not to separate pieces of the claim.”<sup>5</sup> Accordingly, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”<sup>6</sup> If, considering the claim as a whole, the Examiner deems the claim to be obvious in view of the prior art, the Examiner must provide a “clear articulation of the reason(s) why the

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<sup>1</sup> *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1085 (Fed. Cir. 2008).

<sup>2</sup> 383 U.S. 1, 86 S.Ct. 684 (1966)

<sup>3</sup> MPEP § 2142

<sup>4</sup> *Id.*

<sup>5</sup> *Apotex*, 550 F.3d 1075 at 1086. (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed.Cir.1984)).

<sup>6</sup> MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

claimed invention would have been obvious.<sup>7</sup> The Examiner's determination of obviousness "cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>8</sup>

In reviewing an Examiner's determination of obviousness, "the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."<sup>9</sup>

With these principles in mind, the Applicant now turns to the claim rejections, in particular.

**I. The Proposed Combination of Hino and Narasimhan Does Not Render Claims 16, 19-23, 25, 27, 29-32, 36-39, 41, 43 and 45-47 Unpatentable**

**A. Independent Claims 16 and 32**

With regard to the rejection of independent claim 16 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Hino and Narasimhan does not disclose or suggest at least the limitation of "automatically determining authorization for monitoring of the at least one media peripheral using at least one digital certificate; automatically monitoring, by the first system, a plurality of status parameters of the at

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<sup>7</sup> MPEP § 2142.

<sup>8</sup> *KSR*, 550 U.S. 398 at 418 (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)).

<sup>9</sup> *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). See also *In re Vaidyanathan*, Appeal 2009-1404 at 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) ("If the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that [the Appellant's] claims are obvious.").

least one media peripheral, if the authorization is successful, wherein the plurality of status parameters comprises at least two of a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model number, a serial number, and a certificate ID," as recited by the Applicant in independent claim 16.

The Final Office Action states the following:

**Regarding claims 16 and 32,** Hino teaches a method for monitoring at least one media peripheral via a communication network (Column 2, lines 37 - 44), the method comprising: identifying (Column 8, lines 1 - 4) by a first system, at a first location (Column 7, lines 1 - 6, the control device), the at least one media peripheral (Column 6, lines 65 - 67, the home appliance) communicatively coupled a second system, the second system at a second location (Column 6, lines 41 - 51, the gateway (GW) apparatus); establishing a communication link between the first system and the at least one media peripheral (Column 8, lines 12 - 14; lines 22 - 25); determining authorization for monitoring of the at least one media peripheral (Column 19, lines 4 - 10; lines 21 - 22); monitoring, by the first system, at least one status parameter of the at least one media peripheral (Column 9, lines 13 - 18), if the authorization is successful (Column 8, lines 14 - 25); and responding, by the first system, to a state of the at least one status parameter, if the authorization is successful (Column 8, lines 22 - 25); and not monitoring and not responding to a state of the at least one status parameter, if the authorization is not successful (Column 8, lines 20 - 22).

Hino does not explicitly indicate automating the connection to the peripheral. Narasimhan teaches a method of monitoring and controlling network devices that includes creating a program that automatically connects to the controlled devices and retrieves status information to monitor those devices (Column 5, lines 46 - 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Narasimhan's teaching of creating an application that automatically retrieves status information in Hino's system to allow Hino to keep track of device status and database that information.

See Office Action at pages 2-3. Hino "relates to a remote control system for **controlling home appliances** from outside the home and a gateway apparatus used for the remote control system, and in particular, to the system and apparatus capable of controlling the home appliances from outside the home with easier operation." Hino at column 1, lines 7-12 (emphasis added). The gateway apparatus "includes means for acquiring appliance panel information indicating panel parts of the appliance and an operational range of the panel parts, and means for memorizing gateway apparatus information indicating whether a control command input to the appliance through a network built outside the home." *Id.* at Abstract. Additionally, the gateway apparatus "further includes means for determining whether or not it is possible to accept the input by making reference to the gateway apparatus information when the control command input is received through the outside network and for producing a control command to the appliance based on the appliance panel information when the acceptance is possible." *Id.* at Abstract. In general, Hino discloses a system that "makes it possible to perform remote control in a similar feeling obtained in operating a front panel of an actual home appliance." *Id.* at Abstract. That is, an operator may control a home appliance remotely.

With respect to the rejection of independent claims 16 and 32, the Office Action cites Hino at column 2, lines 37-44 as disclosing a "method for automatically monitoring at least one media peripheral via a communication network," as recited, for example, in

claim 16. See Final Office Action, p. 2. This portion of Hino states, however, the following:

The present invention has been made with consideration of the above problems faced by the conventional techniques, and an object of the present invention is to provide, with higher reliability and easier operations, a **remote control system** capable of **controlling home appliances through a network connected to the home**. Also a further object of the present invention is to provide a gateway apparatus for realizing the above remote control system.

Hino at column 2, lines 37-44 (emphasis added). This portion of Hino clearly sets forth a "remote control system" configured to control home appliances. There is nothing in this portion of Hino, however, that describes, teaches or suggests "monitoring," as opposed to controlling, "at least one media peripheral via a communication network," as recited in claims 16 and 32. Further, there is nothing in this portion of Hino that describes, teaches or suggests the control of home appliances being automatic. **Yet furthermore, Hino teaches only controlling home appliances, which are obviously not media peripherals** (the home appliances do not communicate any multimedia information). Thus, for at least this reason, the Final Office Action has not established a *prima facie* case of obviousness with respect to the pending claims because the portion of Hino relied on to disclose the above limitations does not, in fact, describe, teach or suggest the relevant limitations.

Next, the Final Office Action (at p. 3) cites Hino at column 19, lines 4-10 and 21-22 as disclosing "automatically determining authorization for monitoring of the at least

one media peripheral using at least one digital certificate," as recited, for example, in claim 16. This portion of Hino, however, states the following:

Further, the information about terminal identification data includes the number of a cellular phone or the ID of a terminal. The user identification information can be set by making use of authentication information at a terminal with an authentication function or information that proves authentication on authentication service.

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In short, any information can be used in the GW apparatus, as long as the information serves as data to identify inputted information in determining whether or not **it is possible to produce a command.**

Hino at column 19, lines 4-10 and 19-22 (emphasis added). This passage of Hino does not describe, teach or suggest **"automatically determining authorization for monitoring of the at least one media peripheral using at least one digital certificate."** Instead, this passage merely discloses that user identification information can be set by actively selecting authentication information at a terminal (as opposed to **automatically determining**). **Further, any information may be used to determine whether it is possible to produce a command (as opposed to determining authorization for monitoring).** Yet furthermore, Hino is also silent with regard to using any digital certificates for purposes of authorizing monitoring of a digital peripheral. Thus, for at least this reason, the Office Action has not established a *prima facie* case of anticipation with respect to the pending claims because the portion of Hino relied on to disclose "automatically determining authorization for monitoring of the at least one

media peripheral using at least one digital certificate," does not in fact, describe, teach or suggest the relevant limitations.

Next, the Final Office Action (p. 3) cites Hino at column 9, lines 13-18 and column 8, lines 14-25 as disclosing "automatically monitoring, by the first system, a plurality of status parameters of the at least one media peripheral, if the authorization is successful, wherein the plurality of status parameters comprises at least two of a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model number, a serial number, and a certificate ID." Hino states, however, the following:

The GW apparatus can be used as a central **controller** in a factory or an office, in which, **through the keyboard of the GW apparatus, a request** for panel information about appliances, such as **air conditioners, lighting fixtures, and doors**, is issued to monitor the present status of the panel of each appliance on a monitor, or a command is issued to control the operation of air conditioners, the turning lighting fixtures on or off, the open/close of doors, and others.

Hino at column 9, lines 11-18. Initially, the Applicants note that "air conditioners, lighting fixtures, and doors" are not media peripherals. Even assuming Hino was directed to media peripherals, this passage does not disclose that they are automatically monitored, or that **the plurality of monitored parameters includes at least two of a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model**

**number, a serial number, and a certificate ID.** Rather, this passage explicitly states that a user must actively, through the keyboard, input a request for panel information.

Hino also discloses the following:

When receiving **an input** of the control command toward the specified home appliance from the control device 60 or the outside network 50 (step 4), the appliance control command producing means 11 in the GW apparatus 10 determines if or not the control command is possible to be accepted on the basis of the GW apparatus information memorized by the GW apparatus information memorizing means 13.

In the case that the acceptance is impossible, the producing means rejects the control command (step 8). On the other hand, if the acceptance is possible, the appliance control command producing means 11 produces a control command (step 6), and the command outputting means 14 outputs the produced control command (step 7).

Hino at column 8, lines 12-25. There is nothing in this passage of Hino (which the Final Office Action relies on, as noted above) that describes, teaches or suggests **“automatically monitoring, by the first system, at least one status parameter of the at least one media peripheral, if the authorization is successful, wherein the plurality of status parameters comprises at least two of a battery level, an “on/off” indication, an amount of storage used, an amount of storage remaining, a “within range” indication, a software version, a model number, a serial number, and a certificate ID,”** as recited in claim 16. Instead, this passage discloses that after a **control command is input** by a user, the GW apparatus determines whether that control command is acceptable based on stored apparatus information. If the acceptance is impossible, the control command is rejected. If possible, however, the control

command is executed. Thus, this passage of Hino relates to whether a control request actively input by a user is accepted or rejected, but does not describe, teach or suggest "automatically monitoring" a "status parameter of the at least one media peripheral, if authorization is successful." Thus, for at least this reason, the Final Office Action has not established a *prima facie* case of obviousness with respect to the pending claims because the portion of Hino relied on to disclose "automatically monitoring, by the first system, a plurality of status parameters of the at least one media peripheral, if the authorization is successful, wherein the plurality of status parameters comprises at least two of a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model number, a serial number, and a certificate ID," as recited by claim 16.

The Final Office Action also acknowledges that "Hino does not explicitly indicate automating the connection to the peripheral." *See id.* at page 3. As detailed above, Hino does not describe, teach or suggest the various automated limitations of the pending claims.

The Final Office Action goes on to state, however, the following:

Narasimhan teaches a method of monitoring and controlling network devices that includes creating a program that automatically connects to the controlled devices and retrieves status information to monitor those devices (Column 5, lines 46 - 55).

*See id.* at page 3. In order to overcome the deficiencies noted above, the Final Office Action cites Narasimhan at column 5, lines 46-55. *See id.* The cited portion of Narasimhan recites, however, the following:

A web browser or Java virtual machine (JVM) is not required, however, for the client 30 to access a device 34. The present system supports use of additional standard internet capabilities and protocols. Therefore, custom client software can access the equipment directly using standard "sockets." Such software can be developed using conventional programming tools, e.g., BSD Sockets (Unix) or Winsock (Windows). The client 30 also could be an automated application program that collects data from remote devices 34 via the Internet 32. In this way a single client could collect usage data and control thousands of remote devices.

Narasimhan at column 5, lines 46-56. As shown above, this portion of Narasimhan states that the client 30, which is connected to the network, can be an "automated application program that collects data from remote devices 34 via the Internet 32." Thus, a single client could collect usage data, through the automated program, and control thousands of remote devices. **While this portion of Narasimhan merely indicates that usage data may seemingly be automatically collected, it does not describe, teach or suggest, however, at least:**

- **automatically determining authorization for monitoring** of the at least one media peripheral **using at least one digital certificate**; and
- **automatically monitoring**, by the first system, at least one status parameter of the at least one media peripheral, if the authorization is successful, **wherein the plurality of status parameters comprises at least two of a battery level, an "on/off" indication, an amount of storage used, an amount of storage**

**remaining, a “within range” indication, a software version, a model number, a serial number, and a certificate ID.**

Again, the portion of Narasimhan relied on by the Final Office Action noted above merely suggests that the client may automatically collect usage data of a remote device, and through that automatically collected data, may control the remote device. It does not describe, teach or suggest, however, “automatically determining authorization for monitoring of the at least one media peripheral using at least one digital certificate; automatically monitoring, by the first system, a plurality of status parameters of the at least one media peripheral, if the authorization is successful, wherein the plurality of status parameters comprises at least two of a battery level, an “on/off” indication, an amount of storage used, an amount of storage remaining, a “within range” indication, a software version, a model number, a serial number, and a certificate ID.” Instead, Narasimhan broadly states that the “network interface chip manages connections from remote clients automatically, requiring no intervention from the device control circuitry” (*see id.* at column 11, lines 21-23), but “managing” a connection is not the same as “automatically determining authorization” or “automatically monitoring” if the authorization is successful.

Accordingly, the proposed combination of Hino and Narasimhan does not render independent claim 16 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 16 is allowable. Independent claim 32 is similar in many respects to the method disclosed in independent claim 16.

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Therefore, the Applicant submits that independent claim 32 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 16.

**B. Rejection of Dependent Claims 19-23, 25, 27, 29-31, 36-39, 41, 43 and 45-47**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 16 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Narasimhan has been overcome and requests that the rejection be withdrawn. Additionally, claims 19-23, 25, 27, 29-31, 36-39, 41, 43 and 45-47 depend from independent claims 16 and 32, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 16-47.

**1. Rejection of Dependent Claims 21 and 37**

Dependent claims 21 and 37 depend on independent claims 16 and 32, respectively. Therefore, the Applicant submits that claims 21 and 37 are allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 16.

Additionally, the Applicant submits that the combination of Hino and Narasimhan does not disclose or suggest at least the limitation of "the plurality of status parameters

consists of the following: a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model number, a serial number, and a certificate ID," as recited by the Applicant in claim 21. The Final Office Action (p. 4) cites Hino at column 9, lines 17-18 as disclosing these limitations. This portion of Hino, however, discloses the following:

... a command is issued to control the operation of air conditioners, the turning lighting fixtures on or off, the open/close of doors, and others.

Hino at column 9, lines 16-18. **While this portion of Hino discloses that lighting fixtures may be turned on/off, it does not describe, teach or suggest a plurality of status parameters, where the plurality consists of each of the following:** (1) a battery level, (2) an "on/off" indication, (3) an amount of storage used, (4) an amount of storage remaining, (5) a "within range" indication, (6) a software version, (7) a model number, (8) a serial number, and (9) a certificate ID. Thus, for at least this additional reason, the Final Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 21 and 37.

Therefore, the Applicant maintains that the combination of Hino and Narasimhan does not disclose or suggest at least the limitation of "the plurality of status parameters consists of the following: a battery level, an "on/off" indication, an amount of storage used, an amount of storage remaining, a "within range" indication, a software version, a model number, a serial number, and a certificate ID," as recited by the Applicant in claim 21. Claim 37 is similar in many respects to the method disclosed in claim 21.

Therefore, the Applicant submits that claim 37 is also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 21.

**II. Rejection of Dependent Claims 17-18, 26, 28, 33-34, 42 and 44**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 16 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Hino and Narasimhan has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Krzyzanowski) does not overcome the deficiencies of Hino and Narasimhan, claims 17-18, 26, 28, 33-34, 42 and 44 depend from independent claims 16 and 32, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 17-18, 26, 28, 33-34, 42 and 44.

**III. Rejection of Dependent Claims 24 and 40**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 16 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Hino and Narasimhan has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Eytchison) does not overcome the

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deficiencies of Hino and Narasimhan, claims 24 and 40 depend from independent claims 16 and 32, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 24 and 40.

In general, the Final Office Action makes various statements regarding claims 16-47 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

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**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 16-53 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 26-SEPT-2011

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